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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,773	11/14/2003	Timothy J. Flynn	CD-134	8763
42419	7590	09/01/2005	EXAMINER	
PAULEY PETERSEN & ERICKSON 2800 WEST HIGGINS ROAD SUITE 365 HOFFMAN ESTATES, IL 60195			PURVIS, SUE A	
			ART UNIT	PAPER NUMBER
			1734	

DATE MAILED: 09/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/713,773

Applicant(s)

FLYNN ET AL.

Examiner

Sue A. Purvis

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16, 19-23 and 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16, 19-23 and 25 is/are rejected.
- 7) ☒ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings were received on 20 June 2005. These drawings are acceptable.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-7, 10-12, 16, 19, 20, 22, and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Koch.

Regarding claim 1, Koch discloses a method for transferring a label portion onto an object. The label (20) is slid under the stripping members (15) which holds the disk (21) apart from the label prior to the label application to the disk. (Col. 6, lines 19-37.) The adhesive side of the label is exposed and the object is pressed there on. Once the label is applied, the object is removed from the apparatus.

Regarding claim 2, the stripping members (15) are suspended over the application area (10).

Art Unit: 1734

Regarding claim 3, the label assembly (20) is positioned between opposing guides (16a) connected to the apparatus base.

Regarding claim 4, the object or disc in Koch is positionable within a first guide area (13) defined by a first stripping member (15) and opposing second stripping members (15). The stripping members (15) are connected with respect to the apparatus base surface, and a second guide area (13) defined by the opposing second stripping members (15). (See generally Figure 1.)<sup>1</sup>

Regarding claim 5, the recessed portion in Koch corresponds the label portion and the object to be labeled is placed therein. (See Figure 1.)

Regarding claim 6, pressure is applied to the object to apply the label portion to the object. (See Figure 1a.)

Regarding claim 7, the label portion in order to expose the adhesive is separated from the remaining label assembly.

Regarding claim 10, this method is sufficiently detailed above.

Regarding claim 11, the label is indexed by means of the stripping members (15) and hub (18).

Regarding claim 12, the back sheet of the label assembly must be removed from a face sheet of the label assembly to expose the adhesive label portion applied to the disk.

Regarding claim 16, there are multiple gaps between the stripping fingers (15) in Koch as shown by Figure 1.

Regarding claim 19, the object is removed to finish the labeling operation.

Regarding claim 20, the method steps set forth are sufficiently detailed above.

Regarding claim 22, the device of Koch includes a plurality of recessed areas in the application area. (See Figure 1.)

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<sup>1</sup> It should be noted applicant's specification states that the "second guide area" does not necessarily need to be different than the first guide area. (See Page 13, lines 4-6 of the submitted specification.)

Art Unit: 1734

Regarding claim 23, the label is indexed with the stripping members (15) and the hub (18).

4. Claims 20-23 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Ronngard (WO 2001/28866 A1).

Regarding claim 20, the steps for this independent claim are generally set forth in Figures 1 through 5 of Ronngard. It should be noted that the claim does not include language which would require the method to be performed in the order which the applicant lists the steps. Ronngard discloses a method for transferring a label portion from a label assembly onto an object surface comprising positioning the object (38) in one (6) of a plurality of recessed areas (6, 9) formed in a surface of an apparatus base; removing a first portion of a back sheet (32) from a face sheet of the label assembly to expose an adhesive side (42) of the label portion; placing the label assembly into an indexed position with respect to the apparatus and the object surface (Figure 4); positioning the adhesive side of the indexed label portion to contact the object surface (Figure 5); and applying the label portion onto the object surface. The labels outer periphery is indexed by the limiting surface (8) as shown in Figure 1.

Regarding claim 21, further comprising the step of removing the label assembly from the indexed position to transfer the label portion from the label assembly onto the object surface. (See Figure 5.)

Regarding claim 22, the plurality of recessed areas (6, 9) are formed in an application area defined on the apparatus base surface.

Regarding claim 23, during the step of placing the label assembly into the indexed position, the label assembly is positioned within an application area defined on the apparatus base surface. (See Figure 4.)

Art Unit: 1734

Regarding claim 25, the label portion is removed from the label assembly at tearable lines (28) of separation formed on the label assembly.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4, 6-14, 16, 17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wien et al. (US Patent No. 6,748,994 B2) in view of Cook et al. (US Patent No. 6,612,355 B1).

Wien discloses a method for transferring a label portion from a label assembly onto an object. The label (130) is slid within a gap formed between a stripping member (170, 172) and a body member (106) with a support base surface and post (120). The label is positioned on the application area with an adhesive side of the label portion exposed and subsequently the object is contacted with the adhesive side of the label and applied thereto. Once the label is applied, the object is removed with the label portion attached thereto and with a remaining portion of the label assembly being retained by the stripping member. (See Figures 1, 3-5, 14, 122, and 123.)

In Wien the label assembly is not slid underneath opposing stripping members.

Cook, which is also drawn to a method and apparatus for a compact disk, discusses the function of retention elements (44). In Cook, they are positioned on the center peg, but one of ordinary skill in the art would appreciate their function is useful elsewhere. In Cook, the retention elements (44) cooperate with the platen (12) to trap the label (16) between

Art Unit: 1734

the support surface (26) of the platen (12) and the retention elements (44) until the disk (20) is engaged with the hub (14). (Col. 3, lines 44-64.)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use similar retention elements in Wien on the stripping members to ensure the label assembly stays in place on the applicator as the disk is pressed onto the label. One of ordinary skill in the art would appreciate the advantages of using the retention members based on the teachings in Cook.

Regarding claim 2, the stripping members are suspended over the application area of the body member (106).

Regarding claim 3, the label assembly in Wien is positioned between opposing guides connected to the apparatus base.

Regarding claim 4, the object or disc in Wien is positionable within one of a first guide area defined by a first stripping member (170) and opposing second stripping members (172). The stripping members (170, 172) are connected with respect to the apparatus base surface, and a second guide area defined by the opposing second stripping members. (See generally Figure 1.)

Regarding claim 6, pressure is applied to the object to apply the label portion to the object. (See Figures 4 and 5.)

Regarding claim 7, the label portion in Wien is separated from the remaining label assembly, in particular tabs (604) are removed. (Figures 122 and 123.)

Regarding claim 8, the tabs of the label assembly remains on the apparatus following transfer of the label portion onto the object.

Regarding claim 9, a step of transferring a second label portion from the label assembly onto an object is done later, as can be seen by Figures 14, 122 & 123 the label assembly includes additional portions (616, 624).

Art Unit: 1734

Regarding claim 10, most of the features of this claim are substantially detailed above, in addition there is a gap (180, 184) between the stripping member (170) and the base surface. Furthermore, the adhesive must be exposed to achieve the labeling operation. (See Figure 1.)

Regarding claim 11, the label assembly is indexed by means of the stripping members (170, 172).

Regarding claim 12, a portion of a back sheet of the label assembly is removed from a face sheet of the label assembly to expose the label portion. (See Figure 14.)

Regarding claim 13, a pull tab extends from a periphery of the back sheet portion to facilitate removal of the back sheet portion from the face sheet. (Figure 14.)

Regarding claim 14, the label portion comprises one of a standard jewel case spine label and a slim jewel case spine label. (Figures 14, 122, & 123.)

Regarding claim 16, there are multiple gaps in Wien as shown by Figure 1.

Regarding claim 19, the object is removed to finish the labeling operation in Wien.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims have been considered but are moot in view of the new grounds of rejection.
8. Applicant states on page 15 that Claim 10 has been written to include the limitations of claim 18. However, this is not the case. Applicant inserted into claim 10 the language "exposing an adhesive side of the label portion." Original claim 18 required "wherein the adhesive is exposed *after* the label portion is secured between the first stripping member and the second stripping member." The method set forth in claim 10 does not place a temporal limitation on when the adhesive is exposed. The order the applicant lists the steps is not limiting unless there is language included therein which forces the order. Since the



Art Unit: 1734

adhesive must be exposed before the label can be applied in the art used above, the limitations of the claimed invention is met.

9. Regarding the argument with respect to the 35 USC §102(e) rejection over Wien and Sandor, this argument is moot and a new rejection has been made above based on applicant's amendments.

10. Regarding the argument with respect to claims 20-25 rejected using Ronngard, the apparatus of Ronngard includes a recessed or indexed portion which effectively indexes the outer periphery of the label as described above.

#### ***Allowable Subject Matter***

11. Claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no

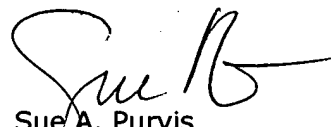
Art Unit: 1734

event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Purvis whose telephone number is (571) 272-1236. The examiner can normally be reached on Monday through Friday 9am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sue A. Purvis  
Primary Examiner  
Art Unit 1734

SP  
August 27, 2005